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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,820	09/20/2001	David Thomas Davies		1047

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SMITHKLINE BEECHAM CORPORATION
CORPORATE INTELLECTUAL PROPERTY-US, UW2220
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EXAMINER

ARCHIE, NINA

ART UNIT	PAPER NUMBER
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1645

MAIL DATE	DELIVERY MODE
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07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/889,820	Applicant(s) DAVIES ET AL.	
	Examiner Nina A. Archie	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,12,14-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,12,14-21 and 23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This Office is responsive to Applicant's amendment and response filed 11-22-06. Claims 1, 12, 14-21 and 23 are pending. Claims 1, 15-21, and 23 have been amended. Claims 2-11, 13, 22 and 24 have been cancelled.

Double Patenting Rejection Maintained

2. The rejections of claims 1, 12, 14-21 and 23 are maintained for the reasons set for in the previous office action.

Applicant arguments:

Claims 1, 12, 14-21 and 23 are provisionally rejected for alleged obviousness-type double patenting over claims 1-10 and 12 of copending Application No. 10/477,900. The Examiner alleges that the claims are not patentably distinct from each other because the 10,477,900 application teaches compounds of formula (I) (citing claims 1-9 and 12), and the present application teaches a method of use claim containing the instant compounds and compositions of the patent application, making the present method claims an obvious variation of the copending application. The Examiner further posits that claim 10 of the copending application (a method of treatment of bacterial infections) broadly encompasses the present application's method of treatment of bacterial infections caused by *S. aureus*, *E. faecalis*, *M. cattarrhalis* or *S. pneumoniae*. Applicant argues that preliminarily, Applicants note that the present application claims are directed to methods of treatment (claims 1, 14-21) and to pharmaceutical compositions (claim 12 and 23). The 10,477,900 application claims are directed to compounds (claims 1-9 and 14), a method of treatment of bacterial infections (claim 10 and 15), a pharmaceutical composition (claim 12) and a process for preparing compounds (claim 13). Applicant argues that the present claims have been amended to define a particular embodiment of the invention, more particularly in regard to the group R4 and specifically R5. Applicants respectfully submit that the 10,477,900 application claims do not teach or suggest such a group R4.

Examiner's Response to Applicant's Arguments:

The examiner accepts that U.S. application No. 10,477,900 teaches compounds of formula (I) (citing claims 1-9 and 12), and the present application teaches a method of use claim containing the instant compounds and compositions of the patent application, making the present method claims an obvious variation of the copending application.

However examiner disagrees that the present claims have been amended to define a particular embodiment of the invention, more particularly in regard to the group R^4 and specifically R^5 . Examiner disagrees that the 10,477,900 application claims do not teach or suggest such a group R^4 . U.S. Application 10,477,900 is obvious over the present claims 1, 12, 14-21 and 23. Although the claims have been amended, in regard to R^4 , the U.S Application 10,477,900 teaches that R^4 is $U-V-R^5$ ($CH_2-CR^{17}R^{18}$) which overlaps with the instant application 09/889820 whereby R^4 is CH_2-R^5 (CH_2 -heteroaryl (C_{1-2})alkyl).

As outlined previously, the instant claims 1, 12, 14-21 and 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 and 12 of copending Application No. 101477,900. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending U.S. application, 10,477,900, teaches compounds of formula (I) and pharmaceutical compositions comprising compound of formula (I) (a product, claims 1-9 and 12); and the present application teaches a method of use claims containing the instant compounds and compositions of the patented application therein which makes the method claims of the present application an obvious variation of the copending application. Claim 10 of the copending application (a method of treatment of bacterial infections with formula (I)) broadly encompasses the present application's method of treatment of bacterial infections caused by *S. aureus*, *E. faecalis*, *M. catarrhalis*, or *S. pneumoniae*.

Conclusion

Status of the Claims

3. No claims are allowed.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina A. Archie whose telephone number is 571-272-9938. The examiner can normally be reached on Monday-Friday 8:30-5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Nina A Archie

Examiner

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REM 3B31


MARK NAVARRO
PRIMARY EXAMINER